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EXAMINER

DAVIS, TEMICA M

ART UNIT PAPER NUMBER

2681

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/405,826

Applicant(s)

WAGNER ET AL.

Examiner

Temica M. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-49 and 53-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-49 and 53-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 35-49 and 53-56 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 35-38 and 40-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al (Smith), U.S. Patent No. 6,333,973.

Regarding claims 35 and 44, Smith discloses a method/means of allowing a user to transmit a message in a portable telephone, the portable telephone including a display device, the method comprising the steps of: receiving previously requested data from a remote source (i.e., from the SMS, e-mail, fax or voice server) (col. 8, lines 27-35, col. 10, lines 17-56; figure 5); displaying information representative of the previously requested data on the display device (col. 8, lines 30-40; figure 7A, 7B, 13A-13D); in response to a user input initiating a transmission mode, automatically selecting a form

for a message to be transmitted based on a content of the displayed information at the time the user input is received as evidenced by the fact that the terminal can determine the ID of the caller and the detect which type of call/message is received (col. 8, lines 52-65, col. 10, line 61-col. 11, line 31).

Regarding claims 36 and 45, Smith discloses a method according to claims 35 and 44, wherein the portable telephone is configured to send and receive electronic mail messages; and wherein the step of automatically selecting a form for a message to be transmitted comprises the step of automatically selecting a form for an outgoing electronic mail message based on a content of the displayed information at the time the user input is received (col. 10, line 38-col. 11, line 31).

Regarding claim 37, Smith discloses a method of enabling a portable telephone to allow a user to transmit a message, the method comprising the step of transmitting sequences of instructions from a host processing system to the portable telephone, the sequences of instructions including instructions which, when executed on the portable telephone, cause the portable telephone to perform the method recited in claim 35 (via processor 3300, col. 5, lines 14-18 and lines 50-57).

Regarding claim 38, Smith discloses a machine-implemented method of allowing a user to transmit a message in a portable telephone, the method comprising the steps of: receiving data from a remote source; monitoring the content of the data for predetermined content; and in response to detecting the predetermined content (i.e., caller information, fax, e-mail, sms, etc), automatically entering a mode for allowing a

user to transmit a message from the telephone (col. 8, lines 26-45, col. 10, line 61-col. 11, line 19; figures 7A, 7B, 13A-13D).

Regarding claim 40, Smith discloses a machine-implemented method according to claim 38, wherein the step of automatically entering a mode for allowing a user to transmit a message from the telephone comprises the step of automatically selecting a format of a message to be transmitted in response to detecting the predetermined content (col. 8, lines 26-45, col. 10, line 61-col. 11, line 31; figures 7A, 7B, 13A-13D).

Regarding claim 41, Smith discloses a machine-implemented method according to claim 40, wherein the telephone is configured to send and receive electronic mail messages and to display received electronic mail messages to a user; and wherein the step of automatically selecting a format of a message to be transmitted comprises the step of automatically selecting a form for an outgoing electronic mail message in response to detecting the predetermined content (col. 8, lines 26-45, col. 10, line 61-col. 11, line 19).

Regarding claim 42, Smith discloses a method of enabling a portable telephone to allow a user to transmit a message, the method comprising the step of transmitting sequences of instructions from a host processing system to the portable telephone, the sequences of instructions including instructions which, when executed on the portable telephone, cause the portable telephone to perform the method recited in claim 38 (col. 5, lines 14-18 and lines 50-5; figure 37).

Regarding claims 43 and 46, Smith discloses a method according to claims 36 and 46, wherein the form is pre-configured to include a destination address (col. 10, lines 61-65; figures 13A-13D, 14A, 14B).

Regarding claim 47, Smith discloses a portable telephone (figures 2 and 3) comprising: an input device (2300); a display device (2400); a transceiver (3100) configured to receive a communication from a remote source over a wireless link; and a control circuit (3300) coupled to the display device and the receiver, the control circuit configured to cause information representative of the communication to be displayed on the display device, the control circuit further configured to detect a user input at the input device initiating a transmission mode, and further configured to respond to the user input by selecting a form for a message to be transmitted based on a content of the displayed information at the time the user input is received (col. 10, line 17-col. 11, line 31).

Regarding claim 48, Smith discloses a portable telephone according to claim 47, wherein the transceiver is configured to send and receive electronic mail messages over the wireless link; and wherein the control circuitry is configured to automatically select a form for an outgoing electronic mail message based on a content of the displayed information at the time the user input is received (col. 5, lines 19-20, col. 10, line 38-col. 11, line 31).

Regarding claim 49, Smith discloses a portable telephone according to claim 48, wherein the form is pre-configured to include a destination address (col. 10, lines 61-65, col. 11, lines 20-31).

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Regarding claim 53, Smith discloses a portable telephone comprising: means for carrying out a two-way telephone communication over a wireless link (col. 4, lines 15-35), means for receiving non-voice data from a remote source (col. 4, lines 15-35); means for monitoring the content of the data for predetermined content; and means, responsive to detecting the predetermined content, for automatically entering a transmission mode for allowing a user to transmit an electronic mail message from the telephone (col. 8, lines 26-45, col. 10, line 61-col. 11, line 9).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 39 and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and Mäkelä et al (Mäkelä).

Regarding claims 39 and 54, Smith discloses a machine-implemented method according to claim 38 as described. Smith, however, fails to disclose wherein the step of automatically entering a mode for allowing a user to transmit a message from the telephone comprises the step of automatically selecting a message to be transmitted in response to detecting the predetermined content.

In a similar field of endeavor, Mäkelä discloses activation of a telephone's own call equipment according to the number of the calling party. Mäkelä further discloses

automatically selecting an SMS message to be transmitted in response to detecting the predetermined content of an incoming call (col. 5, line 53-col. 6, line 16).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Smith with the teachings of Mäkelä for the purpose of saving the user time from having to manually input a reply message.

Regarding claim 55, the combination of Smith and Mäkelä discloses a portable telephone according to claim 54, wherein the means for automatically entering a mode for allowing a user to transmit an electronic mail message from the telephone comprises means for automatically selecting a format of a message to be transmitted in response to detecting the predetermined content (Smith, col. 8, lines 26-45, col. 10, line 61-col. 11, line 19).

Regarding claim 56, Smith discloses a portable telephone communication device comprising: a display device (2400), a transceiver (3100) configured to carry out a two-way telephone communication and further configured to receive non-voice data from a remote source (col. 4, lines 15-35); a control circuit (3300) coupled to the transceiver and the display device (figures 2 and 3), the control circuit configured to detect predetermined content in the non-voice data, to enter a transmission mode for allowing a user to transmit an electronic mail message in response to detecting the predetermined content (col. 10, line 38-col. 11, line 19).

Smith, however, fails to disclose automatically select a message to be transmitted in response to detecting the predetermined content.

Mäkelä reads on this limitation (col. 5, line 53-col. 6, line 16).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Smith with the teachings of Mäkelä for the purpose of saving the user time from having to manually input a reply message.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Helferich, U.S. Patent No. 6,636,733, discloses a wireless messaging method.

Jambhekar et al, U.S. Patent No. 5,848,356, discloses a method for implementing icons in a radio communication device.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (703) 305-4040. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Temica M. Davis
Examiner
Art Unit 2681

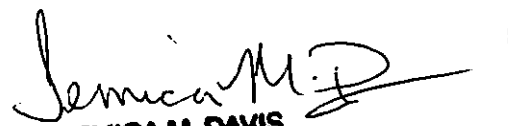
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TMD

January 24, 2004


TEMICA M. DAVIS
PATENT EXAMINER